<center>**Remarks**</center>

1. Introduction

This paper is submitted in response to the non-final Office action mailed May 19, 2005. Claims 1-20 are pending and were rejected in that action for the grounds discussed below. Applicant respectfully traverses the rejections and requests reconsideration in view of the present amendments and the following remarks. Claims 1, 4, 6, 9 and 11 are amended in this response to clarify the subject matter claimed. (Applicant's prior arguments were considered, according to the current Office action, but are now deemed moot in view of new grounds of rejection.)

2. Rejections under 35 U.S.C §112 (second paragraph)

Claims 1, 4, 6 and 9 were rejected under 35 U.S.C §112 (second paragraph) as being indefinite, because: "It is unclear to [the] Examiner how the registry management system can add the new registration for the specific registrar if the deletion of the old registration is pending. Examiner will interpret this limitation to mean acquiring the domain registration <u>after deletion</u>." [Emphasis added.] The Examiner's proposed interpretation of these claims would be <u>incorrect</u>. The present invention is not directed to acquiring a domain registration *after deletion*, as the following remarks will demonstrate. Rather, the invention pertains to transferring a registration to a new registrant while deletion is pending, but before actual deletion.

<center><u>What are the roles of the *Registrar* and the *Registry*?</u></center>

As the Examiner may recall, this distinction is described in the specification:

> "Historically, domain name registration has been conducted through a Shared Registration System (SRS) involving registries, registrars, and registrants. The SRS was created by Network Solutions, Inc. in 1999 to provide a registry backend through which multiple, globally diverse registrars could register domain names. The term "registry" refers to the entity responsible for managing allocation of domain names within a particular name space, such as a TLD. One example of a registry is the VeriSign registry for the .com, .org, and .edu TLDs. ..."

Specification at paragraph [0009].

The term *registry* thus is an established term of art in the field of internet domain name management. It is used as such in the present application and the claims. Importantly, a <u>registry</u> should not be confused with a <u>registrar</u>:

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"The term 'registrar' refers to any one of several entities with authority to issue commands or requests to add, edit, or delete registrations to or from the registry for a name space. Entities that wish to register a domain name do so through a registrar. The term 'registrant' refers to the entity registering the domain name."

Id.

What is *deletion* in this context?

"Deletion" (from the Registry), also called "purge," refers to making a formerly registered, now expired, domain name available to the public (i.e., to all applicable Registrars) so that anyone can register it if they wish. Before that occurs, in accordance with the present invention, a "pending delete" notification is provided to the Domain Name Acquisition System (DAS) before deletion. See Figure 3: "Figure 3 depicts communications and interactions between the Registry and the intermediary's Acquisition Engine. In a prompt and preferably real time manner, the Registry **112** will transmit a message **310** to the IDAS Acquisition Engine **118** indicating that a *domain name is ready to be released* and *will be in a state where it can be re-registered*. This is shown as a "pending delete" notification **310**.... [The] *Registry is about to initiate a final purge* process making the domain name available for re-registration." Paragraph [0043].

This "advance warning" from the Registry system, prior to actual deletion, enables the present DAS to submit its new registration request before the name becomes publicly available. Claim 1 is amended to clarify that the acquisition engine operates to request the registry management system to add the new registration for the specific registrar before the registry system purges the desired domain name. This clarification is believed to obviate the rejection under Section 112 (second paragraph).

Other Clarifications to the Claims under Section 112:

As to **Claim 4**, a similar amendment is submitted to emphasize that the acquisition engine software makes a request to acquire the expiring domain name "prior to the public delete notification".

As to **Claim 6**, please note that it is directed to "A method for acquiring a soon-to-delete domain name" as distinguished from one already deleted. This claim is further amended to clarify the steps of, "receiving from a registry a pending delete notification for the desired domain name, the pending delete notification preceding a public delete notification; and responsive to the received pending delete notification, requesting acquisition of the desired

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domain name for the registrar." Once again, the invention pertains to domain name acquisition prior to actual deletion.

As to **Claim 9**, the method is amended just to emphasize the step of "requesting acquisition of the desired domain name for the registrar before the registry system purges the desired domain name". As explained above, this is made possible by receiving a pending delete notification and acting on it prior to purge.

The Section 112, second paragraph, grounds for rejection thus should be withdrawn.

3. Claims 1-10 are Patentable over Gardos et al. (US Pat. No. 6,880,007) in view of Schneider (US Pat. No. 6,442,549)

Assuming for the present discussion only that the Examiner's characterization of Gardos is accurate, Gardos essentially describes the known registry / registration system, similar to that described in the Background section of the present application.

Regarding Claims 1, 4, 6, 9, 11 and 17, the Examiner quite correctly observed that, "Gardos does not explicitly state the domain name registry system comprising an acquisition database containing an acquisition request from a specific registrar to acquire the domain name as soon as practicable following the expiration and preceding the public delete notification; and an acquisition engine to receive from the registry management system a pending delete notification, the pending delete notification preceding the public delete notification, to access the acquisition request from the acquisition database, and to request the registry management system to add the new registration for the specific registrar." See Office Action, paragraph bridging pages 3-4.

The Examiner cites Schneider as disclosing, "a system pertaining towards the availability of domain names where domain names that may soon be available can be reserved from a server ... and also wherein the completed registration information is submitted by a registrar when the domain name becomes available." Office Action at page 4. However, Schneider does not teach or suggest the combination of a single, centralized acquisition database (which may be thought of as a "waiting list"), and an acquisition engine linked directly to the Registry system, so that it can effect an acquisition of a domain name prior to deletion.

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A. Schneider does not teach or suggest the invention claimed here.

Schneider discloses, in some detail, a system for maintaining a database of United States patents, and tracking which of them are recently expired for non-payment of maintenance fees. Schneider teaches ways to update the database with reduced bandwidth or file size. Schneider asserts that his distributed database maintenance system can be applied to telephone numbers and to domain names. But the system he describes is radically different from the present invention. His system distributes data to subscribers, in a manner that supports searching records for upcoming expirations. Schneider's discussion of domain name registration, aside from the background section, actually consists of about 11 lines of one column, viz:

> "Another field of application pertains to the availability of domain names. In addition to telephone numbers, identifiers such as domain names that may soon be available can be queried by a subscriber 96 or distributed 328 in advance to a subscriber 96 as well, so that domain names of interest can be selected 329 with the option of being ordered, registered, subscribed, or reserved 330 in a preordering queue from either the client 110 or server 114 side. A registration form with completed registration information can be submitted (not shown) to or by a registrar when the soon to be available domain name that is selected does become available for registration." [Emphasis added.]

Column 26, line 60 – column 27, line 4. Note that Schneider teaches submitting a registration form, "**when the ... domain name ... does become available for registration**". That teaching is contrary to the present invention which implements acquisition of a name <u>before</u> it becomes generally available for registration, e.g.: "access the acquisition request from the acquisition database, and to request the registry management system to add the new registration for the specific registrar <u>prior to the public delete notification</u>" (quoting Claim 1).

Schneider says that, "domain names that may soon be available can be queried by a subscriber 96 or distributed 328 in advance to a subscriber 96 as well...". The term "distributed" in this context refers to distributing data (a list of domain names), rather than distributing domain names themselves in the sense of registrations. Neither a query nor a listing achieves a new registration. The present invention, by contrast, is not a subscriber system; and it is not about updates to a distributed database. With all due respect, the Examiner has not shown any teaching or suggestion in Schneider (or Gardos) of the domain name acquisition database and engine or registration methods claimed by the present applicants.

Even if a public service like WHOIS or the Registry system itself were to distribute a list of domain names recently expired but not yet released by the Registry ("pending delete"), that

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distribution would simply encourage the race condition that the present invention overcomes. Who would "subscribe" to receive it? ALL of the Registrars for that Registry or TLD, likely hundreds of them. That is the very problem addressed by the present invention. As explained in the present Specification:

"The challenge arises in that many users or entities are "watching" for availability of the very same names at the very same registries. The "winner" is the registrar (or individual scripting through the registrar's connections to the registry) who can "grab" (register) the newly released name before anyone else. ... In any event, grabbing the name is a high-tech race where only first place wins." (Paragraph [0014].) Schneider does not suggest how to avoid that race. To the contrary, Schneider's suggestion to distribute a list of names that may soon be available simply ignites the race among Registrars to grab a desired name.

The present invention obviates that race. The Specification at paragraph [0022] explains that: "Implementation is simplified and efficiency is improved by integrating the monitor and acquire services directly at the registry of interest. This obviates the need for multiple registrars (or other registration service providers) to constantly "ping" the authoritative database so that loading on the system is relieved. Registrars and other retail-level competitors can avoid the trouble and expense, and especially uncertainty, of the present race-to-grab a name." [emphasis added.]

> "According to the present invention, any and all domain name retailers, such as existing registrars, can participate much more simply in providing monitor and acquire domain name services. The retailer can still offer such services to its customers under the new model, generally through its Web site. Customers can sign up to have the status of a desired name monitored and the name acquired or re-acquired automatically. The retailer no longer needs to perform the monitoring and acquiring steps itself. Rather, the retailer is acting like a reseller of these services. The services are actually provided by a single (i.e., only one is permitted per registry) intermediary entity or software routine implemented at the registry. The intermediary, or the registry implementing software consistent with the present invention, maintains databases of all domain names for which any "retailer" requests monitoring or acquisition on behalf of its customers; together with information identifying the customer." Paragraph [0023], emphasis added.

Applicant's Claim 1 thus is directed to a novel domain name registry system that supports acquisition (or "reallocation") of expiring domain name registrations that are not renewed by their current registrants. The term "expiring" is used to refer to a registration that has passed its nominal expiration date but has not yet been purged from the registry database, in other words

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released to the public. See Abstract. In one embodiment, such a system can be arranged as illustrated in applicant's FIG. 1, reproduced below:
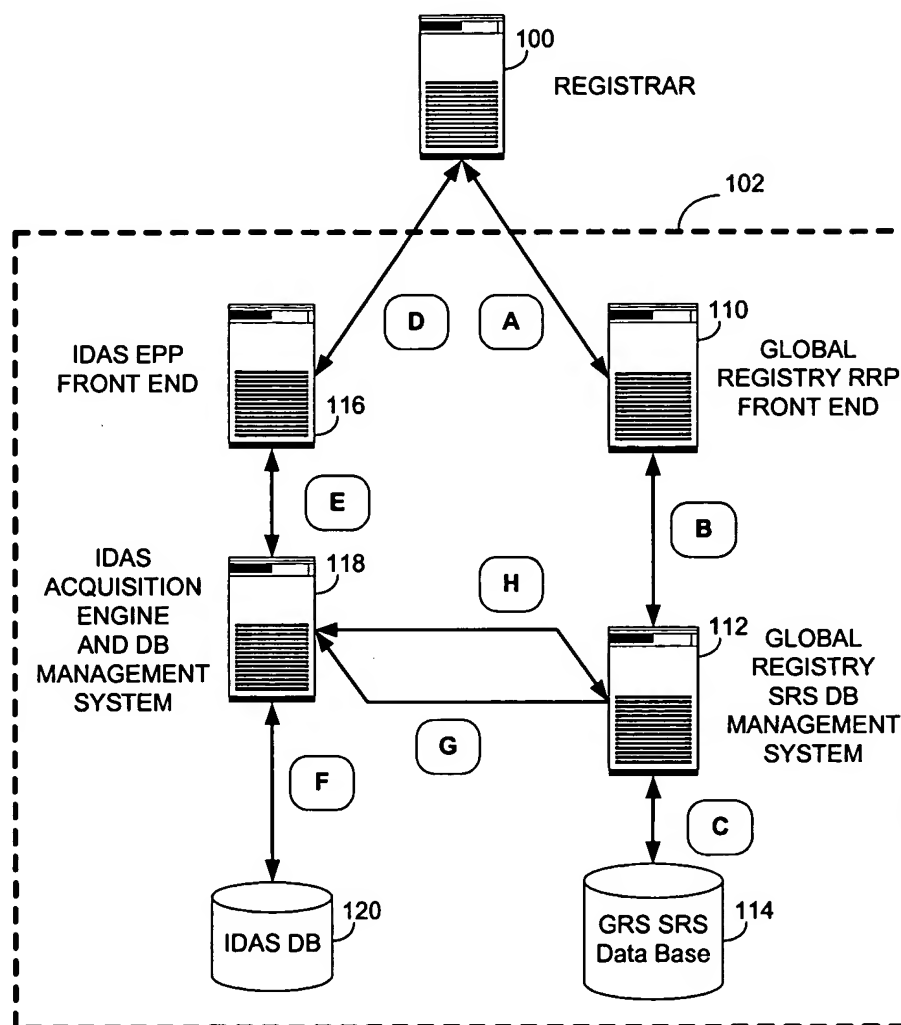
In this example (not intended to limit the scope of the invention), the objects on the right side of the dashed box, namely the "Global Registry RRP Front End (110)," the "Global Registry SRS DB Management System (112)" and the "GRS SRS Data Base (114)," are all known in some fashion in the prior art. They comprise the registry data base system – used to maintain domain name registration records (in database 114). See specification at paragraph [0033].

The elements on the left side of the drawing figure are new, namely the "**IDAS** -- Integrated Domain Acquisition Service -- Front End (116)," the "IDAS Acquisition Engine and DB (database) Management System (118)" and the "IDAS DB (120)."

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According to claim 1, applicant's acquisition database contains a request, "to acquire the domain name as soon as practicable <u>following the expiration date and preceding the public delete notification.</u>" Thus, the acquisition database is akin to a "waiting list" to obtain registration of a (registered) domain name after the current registration expires, but before it is released to the public (i.e., "before the registry system purges the desired domain name").

B. The Examiner's current rejection of Claims 1-10 does not establish a *prima facie* case of obviousness.

The present rejections appear to be based on the following reasoning:

1. The Examiner correctly recognizes one feature of the present invention as "preordering domains that may soon be available."

2. The Examiner asserts that, "if a system allows a user to preorder a domain, it is obvious that the Registrar that the user preorders the domain under has first priority for the domain and is therefore notified of the soon to be available domain before any other Registrar." Office action, page 4, last paragraph. The Examiner has not pointed out in the prior art any disclosure of such a priority assignment.

Rather, the concept of an authoritative "preorder" system that implements centralized coordination (for example, a domain acquisition database or DAS as illustrated in the preferred embodiment) is first taught in the present application. The Examiner falls into the common trap of hindsight reconstruction.

3. The Examiner next posits that the Registrar "is therefore notified of the soon to be available domain before any other Registrar". This assertion is facially logical, but a bootstrap argument. It *assumes* that only one Registrar has a "lock" on the name, but that situation arises only in view of the present invention. There are many competing Registrars, which is the problem the present invention addresses. In the prior art, none of them is notified before the others, as all the Registrars must be treated equally. See paragraph [0017]. Even if this were true, it does not describe the invention claimed here. The present solution in typical embodiments will involve some type of unitary, centralized "acquisition database" that stores requests from all interested Registrars. In this regard, Claim 1 is amended above to recite "a single acquisition database". This is not suggested by Schnieder, which instead emphasizes a distributed database, and does not address the race problem.

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The Examiner contends essentially that Schnieder suggests reserving domain names that are soon to be expired, and that Gardos "provides a system of registering domain names where a domain name server, which includes a domain manager, works with the Registry (Fig. 3, 150, 160, 180, 8, 9)." Office action, page 5. That much may be true, but the combination still would neither describe nor suggest the present claims. The Gardos system is described in the Abstract:

> A program running on a web server allows automated domain name registration, modification and management through an interface running on a client machine. The program redefines the concept of the Domain Name System zones by breaking them down into discrete records that can be managed in a database. The structuring of domain records in such a way allows global modifications to a given record type for all domains owned by a given domain name Registrant. Further, when run on the web server of an accredited registrar, the program enables domain name Registrants an easy and efficient way to reliably monitor and manage their domain name property.

Gardos, while showing a picture at Fig. 3 of a "Domain Manager," does not disclose the use of a centralized acquisition engine coupled to a single acquisition database for capturing names pending deletion. To the contrary, Gardos discloses at Fig. 7 that his "Domain Manager" application (web page) provides only for entering a registration of a currently available (i.e. already purged) domain name. The Gardos page (Fig. 7) says in pertinent part, "IF the domain name you request is available it will automatically be registered." [emphasis added.]. There is no disclosure in Gardos (or in Schneider) of a method for obtaining a name that is not yet available for registration.

For these reasons, the combination of Schnieder and Gardos does not render the present invention unpatentable. The modifications that would be required to reach the present invention, starting from Schneider and Gardos, arise only from hindsight in view of the present disclosure. Therefore, the rejection of claims 1-10 under Section 103(a) should be withdrawn.

C. Additional Rejections.

Regarding claims 10, 12-16 and 18-20, the Examiner asserts that Gardos and Schneider disclosed the limitations "substantially as claimed" as described in claims 9, 11 and 17 including monitoring the status of the current registration of a domain name in order to reserve it once the current registration has expired in the registry (citing Schneider, col. 26, lines 50 et seq.). Applicant traverses the rejection. Claim 10 depends from method claim 9 and thus is patentable at least for the reasons discussed above. Claim 11 is independent; it calls for:

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"11. (Currently amended) A method for domain name management comprising the steps of:

receiving from an interested entity ~~a request to monitor~~ an expression of interest in a currently registered domain name ~~registration maintained by a registry~~ on behalf of a new registrant;

storing the expression of interest;

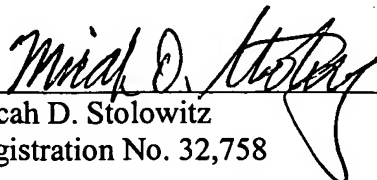detecting that the domain name registration has expired; and

prior to deletion of the expired domain name registration from the registry, requesting a new registration of the domain name in the name of the new registrant to succeed the expired domain name registration."

Here, even assuming that detecting expiration is known, the last step of, "prior to deletion of the expired domain name registration from the registry, requesting a new registration of the domain name in the name of the new registrant to succeed the expired domain name registration" is neither taught nor suggested in the prior art, as discussed above, and the claim as a whole is patentable. The Examiner has not demonstrated a prima facie case to the contrary. The same argument applies to Claim 17. Accordingly the rejection of claims 10-20 should be withdrawn.

For the foregoing reasons, the pending claims are believed to be patentable and prompt allowance is requested. The undersigned would welcome an interview with the Examiner, by telephone or in person, if it would assist the Examiner. Telephone calls should be directed to Micah Stolowitz at 503-294-9189 (direct line).

Respectfully submitted,

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